

ESTTA Tracking number: **ESTTA586862**

Filing date: **02/12/2014**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	SITECORE CORPORATION A/S
Granted to Date of previous extension	02/12/2014
Address	Vester Farimagsgade 3, 5 Copenhagen, V1606 DENMARK
Attorney information	Candice E. Kim Greenberg Traurig, LLP 1840 Century Park East Suite 1900 Los Angeles, CA 90067 UNITED STATES latm2@gtlaw.com Phone:3105863867

Applicant Information

Application No	85835011	Publication date	10/15/2013
Opposition Filing Date	02/12/2014	Opposition Period Ends	02/12/2014
Applicant	Insource Software Solutions, Inc. 11321 Business Center Dr. North Chesterfield, VA 23236 HOLY SEE (VATICAN CITY STATE)		

Goods/Services Affected by Opposition


Class 009. First Use: 0 First Use In Commerce: 0

All goods and services in the class are opposed, namely: COMPUTER SOFTWARE FOR ASSEMBLING DATA RELATING TO MANUFACTURING OPERATIONS INVOLVING UTILIZATION OF PEOPLE, PROCESSES, PROCEDURES AND TECHNOLOGY; COMPUTER SOFTWARE FOR ASSEMBLING DATA RELATING TO MANUFACTURING OPERATIONS; COMPUTER SOFTWARE FOR BUSINESS OPERATIONS FOR TRACKING KEY PERFORMANCE INDICATORS, PROVIDING ACTION AND ACCOUNTABILITY REPORTS, PROVIDING REPORTS ON ADHERENCE TO STANDARDS, PROVIDING FINANCIAL AUDITING; COMPUTER SOFTWARE FOR PROVIDING TRAINING PROGRAMS FOR BUSINESSES; COMPUTER SOFTWARE FOR PROVIDING MANAGEMENT OF TRAINING AND AUDITING

Grounds for Opposition

False suggestion of a connection	Trademark Act section 2(a)
Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)

Mark Cited by Opposer as Basis for Opposition

U.S. Registration No.	2954856	Application Date	11/06/2003
Registration Date	05/24/2005	Foreign Priority Date	NONE
Word Mark	SITECORE		
Design Mark			
Description of Mark	The mark consists of the wording SITECORE and a circle, within which are three swatches of graduated size.		
Goods/Services	Class 009. First use: First Use: 2003/10/30 First Use In Commerce: 2003/10/30 Computer software for managing online content, computer software for editing and managing the information contained on the Internet, intranet and extranet sites, and computer software for development of Internet applications		

Attachments	78323871#TMSN.jpeg(bytes) Notice of Opposition SIGHTCORE.pdf(125982 bytes) SITECORE Exhibits.pdf(253812 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/cek/
Name	Candice E. Kim
Date	02/12/2014

Application Serial No. 85/835,011
Mark: SIGHTCORE
Published in the *Official Gazette* on October 15, 2013

NOTICE OF OPPOSITION


As grounds for the opposition, Opposer asserts as follows:

1. Opposer is a global software development company and an industry leader in web content management and customer experience management software with more than 500 employees, over 8,000 certified developers worldwide, and 17,000 active members in Opposer's developer network. Opposer has offices in Australia, Denmark, Sweden, Canada, Germany, Japan, Netherlands, New Zealand, United Kingdom, Ukraine, and the United States and has received industry accolades from leading media and

analyst organizations including Top Scorer in 2013 Forrester Wave Report “Web Content Management for Digital Customer Experience,” Stratecast Frost & Sullivan 2012 Best Practices Award for Technology Innovation in Customer Engagement Platforms, Software Magazine’s Top 500 ranking of the world’s largest software and service providers, and KMWorld’s 100 Companies that Matter in Knowledge Management. More than 3,000 of the world’s leading brands, including American Express, Carnival Cruise Lines, easyJet, Heineken, LEGO, Microsoft, and Nestle, depend on Opposer to help deliver invaluable customer experiences.

2. Since at least as early as October 2001, Opposer has continuously and exclusively used the mark SITECORE in connection with computer software products, namely, computer software for managing online content, including data, documents, files, information, text, photos, images, graphics, music, audio, video, and multimedia content on various electronic devices.

3. Opposer is the owner of all right, title, and interest in and to the SITECORE mark, including common law rights, and is the owner of a U.S. federal trademark registration for the SITECORE and Design mark, which first use and registration dates back prior to any date on which Applicant can rely. Opposer’s registration for the SITECORE and Design mark has achieved incontestable status and covers the goods below:

Mark	Reg. No.	First Use	Class: Goods/Services
 sitecore	2,954,856 Incontestable Registration	10/30/2003	09: Computer software for managing online content, computer software for editing and managing the information contained on the Internet, intranet and extranet sites, and computer software for development of Internet applications

This registration is valid, subsisting, and in full force and effect, and constitutes *prima facie* evidence of the validity of Opposer’s mark and Opposer’s exclusive right to use the mark on the goods identified in

the registration. A copy of this Registration Certificate and corresponding TSDR status report is attached hereto as Exhibit A and is made part of the record in these proceedings.

4. Beginning at least as early as 2001, continuously through to the present and without abandonment, Opposer has advertised, promoted, and marketed its goods and services in commerce under the SITECORE mark, establishing valuable common law rights in the mark.

5. Through continuous and exclusive use in commerce, and as a result of extensive marketing, promotion, advertising, and distribution, Opposer's well-known SITECORE mark has acquired enormous value and has achieved widespread recognition and fame among the consuming public as a symbol of Opposer's goodwill and reputation as a leading software development company.

6. Applicant INSOURCE SOFTWARE SOLUTIONS, INC. ("Applicant") is a Virginia corporation with a place of business at 11321 Business Center Drive, North Chesterfield, Virginia 23236.

7. According to the United States Patent and Trademark Office ("PTO") records, on or about January 29, 2013, Applicant filed Application Serial No. 85/835,011 to register the mark SIGHTCORE (the "Applicant's Mark") for use in connection with "computer software for assembling data relating to manufacturing operations involving utilization of people, processes, procedures and technology; computer software for assembling data relating to manufacturing operations; computer software for business operations for tracking key performance indicators, providing action and accountability reports, providing reports on adherence to standards, providing financial auditing; computer software for providing training programs for businesses; computer software for providing management of training and auditing" in Class 9. This application was filed on an intent-to-use basis.

8. Applicant's SIGHTCORE mark is the phonetic equivalent of Opposer's SITECORE mark. The beginning portions of the marks are homonyms (SIGHT vs. SITE) and they share the identical suffix "CORE." The two marks sound identical. Because the two marks sound identical, consumers

requesting Opposer's SITECORE products may mistakenly or inadvertently receive Applicant's SIGHTCORE products and vice versa, particularly given the overlapping goods. Accordingly, Applicant's mark is confusingly similar to Opposer's mark.

9. The two marks are also remarkably similar in appearance. Both marks begin with the letters "SI," contain the letter "T" in the middle, and share the identical term "CORE" at the end. Both marks are comprised of two syllables each. In light of these similarities, the marks have a very similar overall commercial impression.

10. Indeed, even the Examining Attorney issued an Office Action, on April 8, 2013, initially refusing registration of Applicant's SIGHTCORE mark based upon a likelihood of confusion with Opposer's SITECORE registration. While the Applicant was able to overcome the Examiner's refusal by merely deleting portions of its ID, it is clear that Applicant's proposed use (as evidenced by the goods covered in Applicant's initial Application and revised Application) overlaps with or is highly related to Opposer's goods.¹ Perhaps more importantly, it bears worth noting that the Examiner concluded that the two marks were confusingly similar in appearance and identical in sound. The Examiner further concluded that the two marks conveyed very similar overall commercial impressions. Attached as Exhibit B is a true and correct copy of this Office Action.

11. Moreover, the addition of a design element in Opposer's SITECORE and Design mark does not sufficiently distinguish the marks since the word portion of a mark is likely to be impressed upon a purchaser's memory and to be used when requesting the goods (in this case, both software

¹ Applicant was able to overcome the refusal by simply deleting the following portions of its ID: "computer software to enhance the audio visual capabilities of multimedia applications, namely, for the integration of text, audio, graphics, still images and moving pictures and to publish multimedia presentations online" in Class 9. Notwithstanding the deleted portions of Applicant's ID, it is undeniable that Applicant's remaining goods clearly overlap with or are highly related to Opposer's goods.

products). Thus, the word portion of a composite mark, containing both words and design, is considered the dominant feature and accorded greater weight in determining whether marks are confusingly similar.

12. The software goods covered in Applicant's Application are overlapping and/or highly related to the software goods that are identified in Opposer's registration in connection with Opposer's SITECORE mark. Specifically, Applicant's "computer software for assembling data relating to manufacturing operations involving utilization of people, processes, procedures and technology; computer software for assembling data relating to manufacturing operations; computer software for business operations for tracking key performance indicators, providing action and accountability reports, providing reports on adherence to standards, providing financial auditing; computer software for providing training programs for businesses; computer software for providing management of training and auditing" is either entirely encompassed by or highly related to Opposer's registration covering "computer software for managing online content, computer software for editing and managing the information contained on the Internet, intranet and extranet sites, and computer software for development of Internet applications."

13. Furthermore, as there are no restrictions contained in Opposer's registration or Applicant's Application, the goods are presumed to travel in the same channels of trade to the same class of purchasers.

14. In view of the confusing similarities between Opposer's SITECORE mark and Applicant's SIGHTCORE mark in sight, sound, and overall commercial impression, and because the goods covered by the respective marks are overlapping or otherwise highly related and presumed to travel in the same channels of trade to the same class of purchasers, registration of Applicant's Mark is likely to cause confusion, mistake or deception among relevant consumers.

15. Applicant's Application was filed on an intent-to-use basis on January 29, 2013, long after Opposer's first use in commerce and registration date of its famous SITECORE and Design mark, which registration is incontestable. Opposer thus has priority of use and registration over Applicant.

16. Upon information and belief, Applicant was on actual notice of Opposer's prior rights in the SITECORE mark before seeking to register Applicant's Mark opposed herein. As a matter of law, based on Opposer's incontestable registration of its SITECORE and Design mark, Applicant was deemed on constructive notice of Opposer's rights in and to the SITECORE mark.

17. Applicant's registration of Applicant's Mark in connection with the goods identified in the Application would be damaging to Opposer.

18. The proposed use and registration by Applicant of Applicant's Mark for the goods identified in Applicant's Application is likely to cause confusion, mistake or deception by having the public erroneously assume or believe that such goods emanate from the same source or origin as Opposer, or are in some other way associated, endorsed, licensed, authorized, sponsored by, or, connected with Opposer, all to Opposer's irreparable damage in violation of Section 2(d) of the Trademark Act of 1946, 15 U.S.C. § 1052(d).

19. Applicant's proposed registration and use of Applicant's Mark would disparage and falsely suggest a connection with Opposer and/or Opposer's goods, thereby causing loss, damage and injury to Opposer, in violation of Section 2(a) of the Trademark Act of 1946, 15 U.S.C. § 1052(a).

20. By reason of the confusing similarities between Applicant's SIGHTCORE mark and Opposer's SITECORE mark, the fame of Opposer's SITECORE mark, and the exclusive association between the SITECORE mark and Opposer, registration of Applicant's Mark would dilute and/or is likely to dilute Opposer's mark by impairing the distinctiveness of Opposer's mark to identify


exclusively goods offered by Opposer. Accordingly, registration of the mark shown in the Application herein opposed violates the Federal Trademark Dilution Act, 15 U.S.C. § 1125(c).

* * * *

For the reasons set forth herein, Opposer believes and asserts that it will be damaged by the registration of Application Serial No. 85/835,011. Accordingly, Opposer prays that this Opposition be sustained, and that Applicant be refused registration of its mark SIGHTCORE for the goods set forth in Application Serial No. 85/835,011.

Respectfully submitted,

Dated: February 12, 2014

By: 
Susan L. Heller
Candice E. Kim
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LATM2@gtlaw.com

Attorneys for Opposer

CERTIFICATE OF SERVICE

I hereby certify that on February 12, 2014, a true and correct copy of the foregoing Notice of Opposition was served via First Class Mail, postage prepaid, to counsel for Applicant and to Applicant at the following:

A. Yates Dowell, III
Dowell & Dowell, P.C.
103 Oronoco Street, Suite 220
Alexandria, Virginia 22314-2046

and to

Insource Software Solutions, Inc.
11321 Business Center Dr.
North Chesterfield, Virginia 23236



EXHIBIT A

Int. Cl.: 9

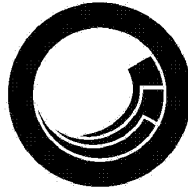
Prior U.S. Cls.: 21, 23, 26, 36 and 38

United States Patent and Trademark Office

Reg. No. 2,954,856

Registered May 24, 2005

**TRADEMARK
PRINCIPAL REGISTER**



sitecore

SITECORE (DENMARK CORPORATION)
TORNEBUSKEGADE 1
COPENHAGEN K, DENMARK DK-1131

FIRST USE 10-30-2003; IN COMMERCE 10-30-2003.

FOR: COMPUTER SOFTWARE FOR MANAGING
ONLINE CONTENT, COMPUTER SOFTWARE FOR
EDITING AND MANAGING THE INFORMATION
CONTAINED ON THE INTERNET, INTRANET
AND EXTRANET SITES, AND COMPUTER SOFT-
WARE FOR DEVELOPMENT OF INTERNET AP-
PLICATIONS, IN CLASS 9 (U.S. CLS. 21, 23, 26, 36
AND 38).

THE MARK CONSISTS OF THE WORDING SITE-
CORE AND A CIRCLE, WITHIN WHICH ARE
THREE SWATCHES OF GRADUATED SIZE.

SER. NO. 78-323,871, FILED 11-6-2003.

JENNIFER KRISP, EXAMINING ATTORNEY

Generated on: This page was generated by TSDR on 2014-02-04 13:53:33 EST

Mark: SITECORE



US Serial Number: 78323871
US Registration Number: 2954856
Register: Principal
Mark Type: Trademark
Status: A Sections 8 and 15 combined declaration has been accepted and acknowledged.
Status Date: Sep. 08, 2010
Publication Date: Mar. 01, 2005

Application Filing Date: Nov. 06, 2003
Registration Date: May 24, 2005

Mark Information

Mark Literal Elements: SITECORE
Standard Character Claim: No
Mark Drawing Type: 3 - AN ILLUSTRATION DRAWING WHICH INCLUDES WORD(S)/ LETTER(S)/NUMBER(S)
Description of Mark: The mark consists of the wording SITECORE and a circle, within which are three swatches of graduated size.
Color(s) Claimed: Color is not claimed as a feature of the mark.
Design Search Code(s): 26.01.21 - Circles that are totally or partially shaded.

Goods and Services

Note: The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;
- Double parenthesis (()) identify any goods/services not claimed in a Section 15 affidavit of
- Asterisks *..* identify additional (new) wording in the goods/services.

For: Computer software for managing online content, computer software for editing and managing the information contained on the Internet, intranet and extranet sites, and computer software for development of Internet applications

International Class(es): 009 - Primary Class
Class Status: ACTIVE
Basis: 1(a)
First Use: Oct. 30, 2003

U.S Class(es): 021, 023, 026, 036, 038
Use in Commerce: Oct. 30, 2003

Basis Information (Case Level)

Filed Use: Yes	Currently Use: Yes	Amended Use: No
Filed ITU: No	Currently ITU: No	Amended ITU: No
Filed 44D: No	Currently 44D: No	Amended 44D: No
Filed 44E: No	Currently 44E: No	Amended 44E: No
Filed 66A: No	Currently 66A: No	
Filed No Basis: No	Currently No Basis: No	

Current Owner(s) Information

Owner Name: SITECORE CORPORATION A/S
Owner Address: Vester Farimagsgade 3, 5
Copenhagen V 1606
DENMARK
Legal Entity Type: CORPORATION
State or Country Where Organized: DENMARK

Attorney/Correspondence Information

Attorney of Record - None

Correspondent

Correspondent Name/Address: Susan L. Heller
GREENBERG TRAURIG, LLP
1840 Century Park East, Suite 1900
Los Angeles, CALIFORNIA 90067-2121
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Phone: (310) 586-7700

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Correspondent e-mail: latm2@gtlaw.com

Correspondent e-mail Authorized: Yes

Domestic Representative - Not Found**Prosecution History**

Date	Description	Proceeding Number
May 01, 2012	TEAS CHANGE OF CORRESPONDENCE RECEIVED	
Mar. 16, 2012	CERTIFICATE OF CORRECTION ISSUED	77315
Mar. 16, 2012	CASE ASSIGNED TO POST REGISTRATION PARALEGAL	77315
Feb. 22, 2012	TEAS SECTION 7 REQUEST RECEIVED	
Sep. 08, 2010	REGISTERED - SEC. 8 (6-YR) ACCEPTED & SEC. 15 ACK.	77315
Sep. 08, 2010	CASE ASSIGNED TO POST REGISTRATION PARALEGAL	77315
Aug. 20, 2010	TEAS SECTION 8 & 15 RECEIVED	
May 24, 2005	REGISTERED-PRINCIPAL REGISTER	
Mar. 01, 2005	PUBLISHED FOR OPPOSITION	
Feb. 09, 2005	NOTICE OF PUBLICATION	
Nov. 09, 2004	LAW OFFICE PUBLICATION REVIEW COMPLETED	74189
Nov. 09, 2004	ASSIGNED TO LIE	74189
Oct. 27, 2004	APPROVED FOR PUB - PRINCIPAL REGISTER	
Oct. 26, 2004	EXAMINER'S AMENDMENT ENTERED	73787
Oct. 25, 2004	EXAMINER'S AMENDMENT ENTERED	59554
Oct. 12, 2004	EXAMINERS AMENDMENT E-MAILED	6328
Oct. 12, 2004	EXAMINERS AMENDMENT -WRITTEN	68309
Sep. 22, 2004	AMENDMENT FROM APPLICANT ENTERED	73787
Sep. 02, 2004	CORRESPONDENCE RECEIVED IN LAW OFFICE	73787
Sep. 02, 2004	TEAS RESPONSE TO OFFICE ACTION RECEIVED	
Jun. 02, 2004	UNRESPONSIVE/DUPLICATE PAPER RECEIVED	73787
Jun. 03, 2004	EMAIL RECEIVED	
Jun. 02, 2004	NON-FINAL ACTION E-MAILED	6325
May 22, 2004	ASSIGNED TO EXAMINER	68309
Dec. 03, 2003	NEW APPLICATION ENTERED IN TRAM	

Maintenance Filings or Post Registration Information

Affidavit of Continued Use: Section 8 - Accepted

Affidavit of Incontestability: Section 15 - Accepted

Change in Registration: Yes

Correction made to Registration: In the statement, Column 1, line 1, "Sitecore" should be deleted, and SITECORE CORPORATION A/S should be inserted.

TM Staff and Location Information**TM Staff Information - None****File Location**

Current Location: Not Found

Date in Location: Apr. 25, 2012

EXHIBIT B

To: Insource Software Solutions, Inc. (yates@dowellpc.com)
Subject: U.S. TRADEMARK APPLICATION NO. 85835011 - SIGHTCORE - 18318TM
Sent: 4/8/2013 4:49:17 PM
Sent As: ECOM106@USPTO.GOV
Attachments: [Attachment - 1](#)
[Attachment - 2](#)
[Attachment - 3](#)
[Attachment - 4](#)

**UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)
OFFICE ACTION (OFFICIAL LETTER) ABOUT APPLICANT'S TRADEMARK APPLICATION**

U.S. APPLICATION SERIAL NO. 85835011

MARK: SIGHTCORE

85835011

CORRESPONDENT ADDRESS:

A. YATES DOWELL, III
DOWELL & DOWELL, P.C.
103 ORONOCO ST STE 220
ALEXANDRIA, VA 22314-2046

CLICK HERE TO RESPOND TO THIS LETTER
http://www.uspto.gov/trademarks/teas/response_forms.jsp

APPLICANT: Insource Software Solutions, Inc.

CORRESPONDENT'S REFERENCE/DOCKET NO :

18318TM

CORRESPONDENT E-MAIL ADDRESS:

yates@dowellpc.com

OFFICE ACTION

STRICT DEADLINE TO RESPOND TO THIS LETTER

TO AVOID PARTIAL ABANDONMENT OF APPLICANT'S TRADEMARK APPLICATION, THE USPTO MUST RECEIVE APPLICANT'S COMPLETE RESPONSE TO THIS LETTER **WITHIN 6 MONTHS** OF THE ISSUE/MAILING DATE BELOW.

ISSUE/MAILING DATE: 4/8/2013

The referenced application has been reviewed by the assigned trademark examining attorney. Applicant must respond timely and completely to the issue below. 15 U.S.C. §1062(b); 37 C.F.R. §§2.62(a), 2.65(a); TMEP §§711, 718.03.

Summary of Issues that Applicant Must Address

1. Trademark Act Section 2(d) PARTIAL Refusal - Likelihood of Confusion

Trademark Act Section 2(d) PARTIAL Refusal – Likelihood of Confusion

THIS REFUSAL APPLIES TO THE FOLLOWING GOODS ONLY: “computer software to enhance the audio-visual capabilities of multimedia applications, namely, for the integration of text, audio, graphics, still images and moving pictures and to publish multimedia presentations online” AND DOES NOT BAR REGISTRATION OF THE REMAINING GOODS.

Registration of the applied-for mark is refused because of a likelihood of confusion with the mark in U.S. Registration No. 2954856. Trademark Act Section 2(d), 15 U.S.C. §1052(d); *see* TMEP §§1207.01 *et seq.* See the enclosed registration at Attachment 1.

Applicant’s mark is SIGHTCORE for, in relevant part, “computer software to enhance the audio-visual capabilities of multimedia applications, namely, for the integration of text, audio, graphics, still images and moving pictures and to publish multimedia presentations online.” Registrant’s mark is SITECORE & design for “Computer software for managing online content, computer software for editing and managing the information contained on the Internet, intranet and extranet sites, and computer software for development of Internet applications.”

Trademark Act Section 2(d) bars registration of an applied-for mark that so resembles a registered mark that it is likely that a potential consumer would be confused, mistaken, or deceived as to the source of the goods and/or services of the applicant and registrant. *See* 15 U.S.C. §1052(d). In the seminal decision *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973), the court listed the principal factors to be considered when determining whether there is a likelihood of confusion under Section 2(d). *See* TMEP §1207.01. However, not all the factors are necessarily relevant or of equal weight, and any one of the factors may control in a given case, depending upon the evidence of record. *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d 1344, 1355, 98 USPQ2d 1253, 1260 (Fed. Cir. 2011); *In re Majestic Distilling Co.*, 315 F.3d 1311, 1315, 65 USPQ2d 1201, 1204 (Fed. Cir. 2003); *see In re E. I. du Pont de Nemours & Co.*, 476 F.2d at 1361-62, 177 USPQ at 567.

In this case, the following factors are the most relevant: similarity of the marks, similarity and nature of the goods, and similarity of the trade channels of the goods. *See In re Vittera Inc.*, 671 F.3d 1358, 1361-62, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); *In re Dakin’s Miniatures Inc.*, 59 USPQ2d 1593, 1595-96 (TTAB 1999); TMEP §§1207.01 *et seq.*

Similarity of the Marks

Marks are compared in their entireties for similarities in appearance, sound, connotation, and commercial impression. *In re Vittera Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (quoting *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973)); TMEP §1207.01(b)-(b)(v). Similarity in any one of these elements may be sufficient to find the marks confusingly similar. *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988); *see In re 1st USA Realty Prof’ls, Inc.*, 84 USPQ2d 1581, 1586 (TTAB 2007); TMEP §1207.01(b).

Marks may be confusingly similar in appearance where there are similar terms or phrases or similar parts of terms or phrases appearing in both applicant's and registrant's mark. *See Crocker Nat'l Bank v. Canadian Imperial Bank of Commerce*, 228 USPQ 689 (TTAB 1986), *aff'd sub nom. Canadian Imperial Bank of Commerce v. Wells Fargo Bank, Nat'l Ass'n*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987) (COMMCASH and COMMUNICASH); *In re Phillips-Van Heusen Corp.*, 228 USPQ 949 (TTAB 1986) (21 CLUB and "21" CLUB (stylized)); *In re Corning Glass Works*, 229 USPQ 65 (TTAB 1985) (CONFIRM and CONFIRMCELLS); *In re Collegian Sportswear Inc.*, 224 USPQ 174 (TTAB 1984) (COLLEGIAN OF CALIFORNIA and COLLEGIENNE); *In re Pellerin Milnor Corp.*, 221 USPQ 558 (TTAB 1983) (MILTRON and MILLTRONICS); *In re BASF A.G.*, 189 USPQ 424 (TTAB 1975) (LUTEXAL and LUTEX); TMEP §1207.01(b)(ii)-(iii).

Applicant's mark is SIGHTCORE and registrant's mark is SITECORE & design. The marks are similar in appearance as first terms in the marks are homonyms ("SIGHT" in applicant's mark and "SITE" in registrant's mark) and the second term in each mark is the word "CORE." The marks are phonetic equivalents and thus have the same sound. Similarity in sound alone may be sufficient to support a finding that the marks are confusingly similar. *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988); *see In re 1st USA Realty Prof'ls, Inc.*, 84 USPQ2d 1581, 1586 (TTAB 2007); TMEP §1207.01(b)(iv). In light of these similarities, the marks have a very similar overall commercial impression.

The addition of the design element in registrant's mark does not sufficiently distinguish the marks. For a composite mark containing both words and a design, the word portion may be more likely to be impressed upon a purchaser's memory and to be used when requesting the goods and/or services. *In re Dakin's Miniatures, Inc.*, 59 USPQ2d 1593, 1596 (TTAB 1999); TMEP §1207.01(c)(ii); *see In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908, 1911 (Fed. Cir. 2012) (citing *CBS Inc. v. Morrow*, 708 F.2d 1579, 1581-82, 218 USPQ 198, 200 (Fed. Cir. 1983)). Thus, although such marks must be compared in their entireties, the word portion is often considered the dominant feature and is accorded greater weight in determining whether marks are confusingly similar, even where the word portion has been disclaimed. *In re Viterra Inc.*, 671 F.3d at 1366, 101 USPQ2d at 1911 (Fed. Cir. 2012) (citing *Giant Food, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565, 1570-71, 218 USPQ2d 390, 395 (Fed. Cir. 1983)). In addition, applicant's mark does not include a design element and could be used in conjunction with a design similar or identical to the one in registrant's mark.

Relatedness of the Goods/Similarity of the Trade Channels

When analyzing an applicant's and registrant's goods and/or services for similarity and relatedness, that determination is based on the descriptions of the goods and/or services stated in the application and registration at issue, not on extrinsic evidence of actual use. *See Octocom Sys. Inc. v. Hous. Computers Servs. Inc.*, 918 F.2d 937, 942, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990); *see also Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 1267, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002).

Absent restrictions in an application and/or registration, the identified goods and/or services are presumed to travel in the same channels of trade to the same class of purchasers. *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d 1344, 1356, 98 USPQ2d 1253, 1261 (Fed. Cir. 2011); *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d at 1268, 62 USPQ2d at 1005. Additionally, unrestricted and broad identifications are presumed to encompass all goods and/or services of the type described. *See In re Jump Designs*, 80 USPQ2d 1370, 1374 (TTAB 2006); *In re Linkvest S.A.*, 24 USPQ2d 1716, 1716 (TTAB 1992).

In this case, the identifications set forth in the application and registration have no restrictions as to

channels of trade or classes of purchasers. Therefore, it is presumed that these goods travel in all normal channels of trade, and are available to the same class of purchasers. Further, the registration uses broad wording to describe the goods and this wording is presumed to encompass all goods of the type described, including those in applicant's more narrow identification.

Specifically, registrant's identification of "Computer software for managing online content, computer software for editing and managing the information contained on the Internet, intranet and extranet site, and computer software for development of Internet applications" encompasses the specific type of online content management and application development software identified by applicant, namely, "computer software to enhance the audio-visual capabilities of multimedia applications, namely, for the integration of text, audio, graphics, still images and moving pictures and to publish multimedia presentations online." These goods are considered legally identical for purposes of a Section 2(d) analysis.

Because applicant's mark is very similar to registrant's mark in appearance, sound and overall commercial impression and because applicant's goods, in relevant part, are legally identical to registrant's goods, there is a likelihood of confusion as to the source of the goods.

Although applicant's mark has been refused registration as to the goods "computer software to enhance the audio-visual capabilities of multimedia applications, namely, for the integration of text, audio, graphics, still images and moving pictures and to publish multimedia presentations online," applicant may respond to the refusal by submitting evidence and arguments in support of registration. Applicant may also choose to respond by deleting from the application the goods to which the refusal applies.

ADVISORY – Partial Abandonment of Goods

If applicant does not respond to this Office action within the six-month period for response, the following goods will be **deleted** from the application: "computer software to enhance the audio-visual capabilities of multimedia applications, namely, for the integration of text, audio, graphics, still images and moving pictures and to publish multimedia presentations online."

The application will then proceed with the following goods only: "computer software for assembling data relating to manufacturing operations involving utilization of people, processes, procedures and technology; computer software for assembling data relating to manufacturing operations; computer software for business operations for tracking key performance indicators, providing action and accountability reports, providing reports on adherence to standards, providing financial auditing; computer software for providing training programs for businesses; computer software for providing management of training and auditing." *See* 37 C.F.R. §2.65(a); TMEP §718.02(a).

If applicant has any questions about this Office action, please contact the undersigned examining attorney.

/Linda Lavache/
Trademark Examining Attorney
Law Office 106
p. 571.272.7187
f. 571.273.9106
linda.lavache@uspto.gov (informal inquiries only)

TO RESPOND TO THIS LETTER: Go to http://www.uspto.gov/trademarks/teas/response_forms.jsp. Please wait 48-72 hours from the issue/ mailing date before using the Trademark Electronic Application System (TEAS), to allow for necessary system updates of the application. For *technical* assistance with online forms, e-mail TEAS@uspto.gov. For questions about the Office action itself, please contact the assigned trademark examining attorney. **E-mail communications will not be accepted as responses to Office actions; therefore, do not respond to this Office action by e-mail.**

All informal e-mail communications relevant to this application will be placed in the official application record.

WHO MUST SIGN THE RESPONSE: It must be personally signed by an individual applicant or someone with legal authority to bind an applicant (i.e., a corporate officer, a general partner, all joint applicants). If an applicant is represented by an attorney, the attorney must sign the response.

PERIODICALLY CHECK THE STATUS OF THE APPLICATION: To ensure that applicant does not miss crucial deadlines or official notices, check the status of the application every three to four months using the Trademark Status and Document Retrieval (TSDR) system at <http://tsdr.uspto.gov/>. Please keep a copy of the TSDR status screen. If the status shows no change for more than six months, contact the Trademark Assistance Center by e-mail at TrademarkAssistanceCenter@uspto.gov or call 1-800-786-9199. For more information on checking status, see <http://www.uspto.gov/trademarks/process/status/>.

TO UPDATE CORRESPONDENCE/E-MAIL ADDRESS: Use the TEAS form at <http://www.uspto.gov/trademarks/teas/correspondence.jsp>.

Attachment 1

DESIGN MARK

Serial Number

78323871

Status

SECTION 8 & 15-ACCEPTED AND ACKNOWLEDGED

Word Mark

SITECORE

Standard Character Mark

No

Registration Number

2954856

Date Registered

2005/05/24

Type of Mark

TRADEMARK

Register

PRINCIPAL

Mark Drawing Code

(3) DESIGN PLUS WORDS, LETTERS AND/OR NUMBERS

Owner

SITECORE CORPORATION A/S CORPORATION DENMARK Vester Farimagsgade 3, 5
Copenhagen V DENMARK 1606

Goods/Services

Class Status -- ACTIVE. IC 009. US 021 023 026 036 038. G & S:
Computer software for managing online content, computer software for
editing and managing the information contained on the Internet,
intranet and extranet sites, and computer software for development of
Internet applications. First Use: 2003/10/30. First Use In Commerce:
2003/10/30.

Description of Mark

The mark consists of the wording SITECORE and a circle, within which
are three swatches of graduated size.

Colors Claimed

Color is not claimed as a feature of the mark.

Filing Date

2003/11/06

Print: Apr 8, 2013

78323871

Examining Attorney
KRISP, JENNIFER



sitecore

To: Insource Software Solutions, Inc. (yates@dowellpc.com)
Subject: U.S. TRADEMARK APPLICATION NO. 85835011 - SIGHTCORE - 18318TM
Sent: 4/8/2013 4:49:18 PM
Sent As: ECOM106@USPTO.GOV
Attachments:

UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

**IMPORTANT NOTICE REGARDING YOUR
U.S. TRADEMARK APPLICATION**

USPTO OFFICE ACTION (OFFICIAL LETTER) HAS ISSUED
ON **4/8/2013** FOR U.S. APPLICATION SERIAL NO. 85835011

Please follow the instructions below:

(1) TO READ THE LETTER: Click on this [link](#) or go to <http://tsdr.uspto.gov>, enter the U.S. application serial number, and click on "Documents."

The Office action may not be immediately viewable, to allow for necessary system updates of the application, but will be available within 24 hours of this e-mail notification.

(2) TIMELY RESPONSE IS REQUIRED: Please carefully review the Office action to determine (1) how to respond, and (2) the applicable response time period. Your response deadline will be calculated from **4/8/2013** (*or sooner if specified in the Office action*). For information regarding response time periods, see <http://www.uspto.gov/trademarks/process/status/responsetime.jsp>.

Do NOT hit "Reply" to this e-mail notification, or otherwise e-mail your response because the USPTO does NOT accept e-mails as responses to Office actions. Instead, the USPTO recommends that you respond online using the Trademark Electronic Application System (TEAS) response form located at http://www.uspto.gov/trademarks/teas/response_forms.jsp.

(3) QUESTIONS: For questions about the contents of the Office action itself, please contact the assigned trademark examining attorney. For *technical* assistance in accessing or viewing the Office action in the Trademark Status and Document Retrieval (TSDR) system, please e-mail TSDR@uspto.gov.

WARNING

Failure to file the required response by the applicable response deadline will result in the

ABANDONMENT of your application. For more information regarding abandonment, see <http://www.uspto.gov/trademarks/basics/abandon.jsp>.

PRIVATE COMPANY SOLICITATIONS REGARDING YOUR APPLICATION: Private companies **not** associated with the USPTO are using information provided in trademark applications to mail or e-mail trademark-related solicitations. These companies often use names that closely resemble the USPTO and their solicitations may look like an official government document. Many solicitations require that you pay “fees.”

Please carefully review all correspondence you receive regarding this application to make sure that you are responding to an official document from the USPTO rather than a private company solicitation. All official USPTO correspondence will be mailed only from the “United States Patent and Trademark Office” in Alexandria, VA; or sent by e-mail from the domain “@uspto.gov.” For more information on how to handle private company solicitations, see http://www.uspto.gov/trademarks/solicitation_warnings.jsp.